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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,637	03/29/2004	Cordell R. Burton	26998-247823	4152

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MINNEAPOLIS, MN 55402-3901

EXAMINER
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LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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09/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,637	<b>Applicant(s)</b> BURTON ET AL.	
	<b>Examiner</b> JESSICA LAUX	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-23 and 25-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-23, 25-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 4-23, 25-46 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the Prior Art reference of Hunter it is noted that the reference is only relied up for its teaching of using a foam adhesive for structural attachment purposes, and therefore the specific design and application layout of the adhesive is moot for the present purposes.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-2, 4-21 are written as method claims, however the body of the claims recite features and limitations of a structure/apparatus claim, causing confusion (i.e. wherein the foam... provides at least 50% of an attachment force...; it is noted that language similar to "attaching solely(or similar) with the foam" would be acceptable limitations for a method claim). When examining method claims limitations to the structure, not necessary for the recited methods are not given patentable weight. The claims will be examined as best understood, but it is noted that the prior art references below are at least capable of providing a percent/primary/sole attachment force.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4-23, 25-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant admitted prior art and Braun et al (6894083) and further in view of Hunter (7168221).**

Regarding claims 1-2, 4-5, 8-10, 21-23, 25-26, 29-31, 38-40, 42-44, 46: Applicant admits in the specification that it is known in the art to have a composite panel having an insulating core (spec page 1) and a fenestration unit installed in the panel (where the steps of installing would inherently include the steps of creating an opening larger than the fenestration unit and positioning the unit inside the opening).

Braun discloses a low expansion foam installed around a perimeter of an installed fenestration unit in a building panel (Cols 1-4), where the foam completely or substantially surrounds the fenestration unit and seals the fenestration unit in place.

It would have been obvious at the time the invention was made to modify the already known method of installing a fenestration unit in panel (as disclosed by applicant) to include using a foam adhesive around at least a portion of the perimeter of the unit (as disclosed by Braun) to secure the unit and panel because the foam adhesive provides a secure connection that further protects from water/moisture

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damage and provides additional insulation at an area that is known to require insulation (a fenestration opening in a wall/panel).

The limitation in the claims regarding the percentage (ranging in the various dependent claims from 100-50%) appears to be a mere matter of design choice which fails to patentably distinguish over the prior art. Applicant has disclosed that several percentages would be acceptable, including that the adhesive provides the sole structural support and that it provides mere 50% of the attachment force. Such a range is clearly indicative of a lack of criticality to the instant feature. Moreover it appears that a foam adhesive that provides at least 50% of the attachment force either by itself or in combination with other fastening means would be acceptable and within the scope of applicant invention.

While Braun does not expressly disclose that the foam provides a percentage or primary/sole structural attachment Hunter discloses that it is known to use foam adhesives for securing, particularly when securing to foam (such as the claimed panels).

Therefore it would have been well within the general skill and knowledge of one of ordinary skill in the art at the time the invention was made to pursue the known options or techniques of using a foam adhesive for structural attachment of a fenestration unit in a composite panel, as the foam provides an additional moisture and insulation barrier and is already commonly employed in such an application.

Regarding claims 6, 27, 41: The method/structure of claims 1, 22 or 39 comprising selecting a foam material that is compatible with a material of the

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insulating core of the composite panel (it is inherent and obvious to one of ordinary skill in the art to use an adhesive that is compatible with the material to which the adhesive will be applied).

Regarding claims 7,28: The method/structure of claims 1or 22 comprising fixedly adhering the foam material to at least one side surface of an outer layer of the composite wall panel at the rough opening (Braun - figure 1; Col. 3, lines 42-45).

Regarding claims 11-13, 32-34: Where applicant admits in the specification that it is known in the art to attach a fin on the frame of the fenestration unit to an outer surface of an outer layer of the composite panel and locating a sealant material between the fin and the outer surface of the outer layer and attaching the fin to the outer layer using fasteners.

Regarding claims 14, 35: The method /structure of claims 1or 22 comprising delivering the foam material into recesses located in the perimeter of the frame (Braun – Col. 3).

Regarding claims 16-19: Admitted prior art in view of Braun and Hunter disclose the method as in claim 1 above, but is silent regarding where the panel and fenestration installation method occurs. However, applicant has not disclosed that the claimed limitations of fabricating and assembling either at a remote location or on side, provide and advantage, solve a stated problem or are for a particular purpose. Furthermore it appears that either location would be acceptable and result in the same product and therefore it appears to be a mere matter of obvious design choice to one of ordinary skill

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in the art to either assemble/fabricated on site or at a remote location as these are the only options and the method must be performed at one and/or the other.

Claims 15,36, 45: Examiner takes official notice that it is common and well known to use an intermediate adhesion promoting material when applying an adhesive layer to a material to be adhered to another material, and that as such it would have been obvious to one of ordinary skill in the art to apply such a material to the perimeter of the frame to provide a more secure adhesive connection.

Claims 20,37,46: The prior art discloses a method/structure of claims 1,22 or 39 as above, but does not expressly disclose that the insulting core comprises a polymeric foam material. However, it is notoriously common and well known in the art of building panels and insulation to use polymeric foam for its excellent insulating properties. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the core of the above disclosed panel of polymeric foam as its properties are well known and would produce the predictable results of a structurally sound and well insulated building panel.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/J. L./  
Examiner, Art Unit 3635